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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,034

03/19/2004

Paul Lapstun

NPA136US

7056

24011

7590

07/14/2006

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EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,034	<b>Applicant(s)</b> LAPSTUN ET AL.	
	<b>Examiner</b> Thierry L. Pham	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/693,219.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                       |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/19/04, 1/18/05</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

- This action is responsive to the following communication: Continuation application filed on 3/19/04.
- Claims 1-8 are currently pending in application.
- IDS filed on 3/19/04 & 1/18/05 have been considered by the examiner, and herein attached with Office Action.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: please replace “f” with “of” on line 3 of claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1- are rejected under 35 U.S.C. 102(e) as being anticipated by Mori (US 6137590).

Regarding claim 1, Mori discloses a copier (fig. 3) including: a scanner (different types of scanners can be used, col. 4, lines 25-35 and col. 5, lines 40-45) for scanning a document which may contain both document content and first coded data indicative of an identity of the document and enabling formation of a digital image of the document; a detector (bar-code reader of identification code read section 8, fig. 6, col. 5, lines 4-62) for detecting if the document contains said first coded data (coded data 10a, fig. 7); a printer (printing section 5, fig. 6) adapted for

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printing a copy of the printed document and for incorporating in said printed copy second coded data indicative of an identity of the copy (col. 3, lines 55-67).

Regarding claim 2, Mori further discloses a copier according to claim 1 further including a network interface (I/F 2, fig. 1, col. 3, lines 25-28 and col. 4, lines 40-60) for transmitting to a computer system data indicative of said first coded data and for receiving from said computer system response data (fig. 15) indicative of an identity of the copy.

Regarding claim 3, Mori further discloses a copier according to claim 2 further including a coded data generator (identification code assignment section 7, fig. 6) adapted to generate said second coded data from said response data.

Regarding claim 4, Mori further discloses a copier according to claim 1 wherein said copier is adapted to communicate (I/F 2, fig. 1, col. 10, lines 45-55) with a server (col. 4, lines 60-63) for allocating a unique identifier to each copy.

Regarding claim 5, Mori further discloses a copier according to claim 4 wherein data indicative of said unique identifier is incorporated into said second coded data (barcode 10a, fig. 7) and is printed in said printed copy.

Regarding claim 7, Mori further discloses a copier according to claim 2 further adapted to transmit through said network interface (I/F 2, fig. 1) second document data representing said copy of the document to enable said second document data to be stored.

Regarding claim 8, Mori further discloses a copier according to claim 7 wherein said second document data can be retrieved (retrieving digital copy via scanning barcode 10a, fig. 7) through said network interface to enable reproduction of said copy with both document content and coded data.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as described in claim 1 above, and in view of Dymetman et al (US 6330976).

Regarding claim 6, Mori discloses a second coded data indicative of an identity of the copy, but fails to teach and/or suggest wherein a second coded data device is indicative of a plurality of reference points on a printed copy to identify the position of the sensing device relative to the copy.

Dymetman, in the same field of endeavor for printing, teaches a second coded data indicative of an identity of the copy, but fails to teach and/or suggest wherein a second coded data device (col. 3, lines 50-67 and col. 9, lines 15-21) is indicative of a plurality of reference points on a printed copy to identify the position (location identifier coded data for identifying location of a photograph, zone, and etc within a document, col. 3, lines 58-67 and col. 8, lines 60-67) of the sensing device relative to the copy.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Mori's invention to include coded data identifying a position of the sensing device relative to the copy as taught by Dymetman because of a following reason: (●) the bar reader not only reads embedded coded data, but also determines the exact location/position of its pointer; by doing so, it ensures the users that the right coded data is read; (●) adding a location identifier coded data to identify the position of the sensing device relative to the copy. helps user to easily locate the location of the tags.

Therefore, it would have been obvious to combine Mori with Dymetman to obtain the invention as specified in claim 6.

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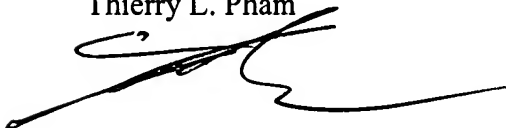
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



GABRIEL I. GARCIA  
PRIMARY EXAMINER